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UTILITY
PATENT APPLICATION
TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

99365CON

First Inventor

Todd W. Antrim

Title

METHOD FOR PROVIDING...

Express Mail Label No.

ER524410247US

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

Commissioner for Patents
Mail Stop Patent Application
P.O. Box 1450
Alexandria VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 17]
(preferred arrangement set forth below)
- Descriptive title of the invention
- Cross Reference to Related Applications
- Statement Regarding Fed sponsored R & D
- Reference to sequence listing, a table,
or a computer program listing appendix
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (if filed)
- Detailed Description
- Claim(s)
- Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 2]
5. Oath or Declaration [Total Sheets 6]
a. ☐ Newly executed (original or copy)
b. ☒ Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 18 completed)
i. ☐ DELETION OF INVENTOR(S)
Signed statement attached deleting inventor(s)
name in the prior application, see 37 CFR
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)

a. ☐ Computer Reader Form (CRF)

b. Specification Sequence Listing on:

i. ☐ CD-ROM or CD-R (2 copies); orii. ☐ Paperc. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☒ copy of parent
Assignment Papers
10. ☒ 37 CFR 3.73(b) Statement of Invention
(when there is an assignee) ☒ Power of
Attorney ☒ copy of
11. ☐ English Translation Document (if applicable)
12. ☒ Information Disclosure
Statement (IDS)/PTO-1499 ☐ Copies of IDS
Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☒ Nonpublication Request under 35 U.S.C. 122
(b)(2)(B)(i). Applicant must attach form PTO/SB/35
or its equivalent
17. ☒ Other: COMMUNICATION WITH
CONTINUING APPLICATION

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation☐ Divisional☐ Continuation-in-part (CIP)of prior application No.: 09/454,848

Prior application information:

Examiner Quoc Duc TranArt Unit: 2643

For CONTINUATION OF DIVISIONAL APPS only; The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label

2685

(Insert Customer No. or Attach bar code label here)

OR ☐ Correspondence address below

Name

Address

City

State

Zip Code

Country

Telephone

Fax

Name (Print/Type)

Mark G. Knedeisen

Registration No. (Attorney/Agent)

42,747

Signature

Mark G. Knedeisen

Date

9/12/03

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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 PTO
10/661338
09/12/03

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FEE TRANSMITTAL
for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 750.00**Complete if Known**

| | |
|----------------------|-------------|
| Application Number | |
| Filing Date | |
| First Named Inventor | Todd Antrim |
| Examiner Name | |
| Art Unit | |
| Attorney Docket No. | 99365CON |

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit Account Number
Deposit Account Name

11-1110

Kirkpatrick & Lockhart LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.
FEE CALCULATION**1. BASIC FILING FEE**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|------------------------|--------------------|
| 1001 750 | 2001 375 | Utility filing fee | 750.00 |
| 1002 330 | 2002 165 | Design filing fee | |
| 1003 520 | 2003 260 | Plant filing fee | |
| 1004 750 | 2004 375 | Reissue filing fee | |
| 1005 160 | 2005 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | (\$) 750.00 |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims 20 -20** = 0 X Fee from below = -0-
 Independent Claims 2 -3** = 0 X Fee from below = -0-
 Multiple Dependent Claims

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description |
|----------------------------|----------------------------|--|
| 1202 18 | 2202 9 | Claims in excess of 20 |
| 1201 84 | 2201 42 | Independent claims in excess of 3 |
| 1203 280 | 2203 140 | Multiple dependent claim, if not paid |
| 1204 84 | 2204 42 | ** Reissue independent claims over original patent |
| 1205 18 | 2205 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$) -0-

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

| Fee Code (\$) | Fee Code (\$) | Fee Code (\$) | Fee Code (\$) | Fee Description | Fee Paid |
|---------------|---------------|---------------|---------------|--|----------|
| 1051 130 | 2051 65 | 1052 50 | 2052 25 | Surcharge - late filing fee or oath | |
| 1053 130 | 1053 130 | 1812 2,520 | 1812 2,520 | Surcharge - late provisional filing fee or cover sheet | |
| 1804 920* | 1804 920* | 1805 1,840* | 1805 1,840* | Non-English specification | |
| 1805 1,840* | 1805 1,840* | 2251 55 | 2251 55 | For filing a request for ex parte reexamination | |
| 1251 110 | 2251 55 | 2252 205 | 2252 205 | Requesting publication of SIR prior to Examiner action | |
| 1252 410 | 2252 205 | 2253 465 | 2253 465 | Requesting publication of SIR after Examiner action | |
| 1253 930 | 2253 465 | 2254 725 | 2254 725 | Extension for reply within first month | |
| 1254 1,450 | 2254 725 | 2255 985 | 2255 985 | Extension for reply within second month | |
| 1255 1,970 | 2255 985 | 2401 160 | 2401 160 | Extension for reply within third month | |
| 1401 320 | 2401 160 | 2402 160 | 2402 160 | Extension for reply within fourth month | |
| 1402 320 | 2402 160 | 2403 140 | 2403 140 | Extension for reply within fifth month | |
| 1403 280 | 2403 140 | 1451 1,510 | 1451 1,510 | Notice of Appeal | |
| 1451 1,510 | 1451 1,510 | 1452 110 | 1452 110 | Filing a brief in support of an appeal | |
| 1452 110 | 1452 110 | 1453 1,300 | 1453 1,300 | Request for oral hearing | |
| 1453 1,300 | 1453 1,300 | 1501 1,300 | 1501 1,300 | Petition to institute a public use proceeding | |
| 1501 1,300 | 1501 1,300 | 1502 470 | 1502 470 | Petition to revive - unavoidable | |
| 1502 470 | 1502 470 | 1503 630 | 1503 630 | Petition to revive - unintentional | |
| 1460 130 | 1460 130 | 1460 130 | 1460 130 | Utility issue fee (or reissue) | |
| 1807 50 | 1807 50 | 1807 50 | 1807 50 | Design issue fee | |
| 1806 180 | 1806 180 | 8021 40 | 8021 40 | Plant issue fee | |
| 8021 40 | 8021 40 | 1809 750 | 1809 750 | Petitions to the Commissioner | |
| 1809 750 | 1809 750 | 1810 750 | 1810 750 | Processing fee under 37 CFR 1.17(q) | |
| 1810 750 | 1810 750 | 1801 750 | 1801 750 | Submission of Information Disclosure Stmt | |
| 1801 750 | 1801 750 | 1802 900 | 1802 900 | Recording each patent assignment per property (times number of properties) | |
| 1802 900 | 1802 900 | | | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| | | | | For each additional invention to be examined (37 CFR 1.129(b)) | |
| | | | | Request for Continued Examination (RCE) | |
| | | | | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) -0-**SUBMITTED BY**

| | | | | | |
|-------------------|-----------------------|-----------------------------------|---------|-----------|--------------|
| Name (Print/Type) | Mark G. Knedeisen | Registration No. (Attorney/Agent) | 42,747 | Telephone | 412/355-6342 |
| Signature | <i>Mark Knedeisen</i> | Date | 9/12/02 | | |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**NONPUBLICATION REQUEST
UNDER
35 U.S.C. 122(b)(2)(B)(i)**

First Named Inventor

Todd W. Antrim

Title

METHOD FOR PROVIDING TELEPHONE...

Attorney Docket Number

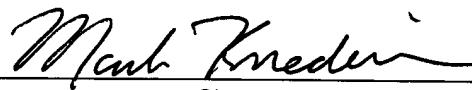
99365CON

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

I hereby request that the attached application not be published under 35 U.S.C. 122(b).

9/12/03

Date



Signature

412/355-6342

Telephone number

Mark G. Knedeisen

Typed or printed name

This request must be signed in compliance with 37 CFR 1.33(b) and submitted with the application **upon filing**.

Applicant may rescind this nonpublication request at any time. If applicant rescinds a request that an application not be published under 35 U.S.C. 122(b), the application will be scheduled for publication at eighteen months from the earliest claimed filing date for which a benefit is claimed.

If applicant subsequently files an application directed to the invention disclosed in the attached application in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant **must** notify the United States Patent and Trademark Office of such filing within forty-five (45) days after the date of the filing of such foreign or international application. **Failure to do so will result in abandonment of this application (35 U.S.C. 122(b)(2)(B)(iii)).**

This collection of information is required by 37 CFR 1.213(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Applicant: Antrim et al.)
)
Serial No.:) **Examiner:**
)
) **Art Unit:**
Filing Date:)

COMMUNICATION WITH CONTINUING APPLICATION

September 12, 2003

Dear Sir:

This communication is being submitted with the above-captioned application (hereinafter, the “subject application”), which is a continuation of U.S. Patent Application Serial No. 09/454,848, filed December 7, 1999 (the “parent application”).

PI-1044275 v1 0224285-0361

application, and in particular paragraph [005] of the subject application, has been amended to reflect the wording of claim 1 of the subject application.

Applicants are also concurrently filing an Information Disclosure Statement listing all the references cited during prosecution of the parent application. Pursuant to 37 C.F.R. § 1.98(d) copies of the references are not enclosed, although Applicants will be happy to provide them upon request.

Additionally, Applicants provide the following Remarks regarding the patentability of the pending claims of the application.

REMARKS

Claims 1-5 of the subject application match claims 1-5 of the parent application as amended and as rejected in the Office Action mailed July 28, 2003 in connection with the parent application. In that Office Action, claims 1 and 2 were rejected as being obvious over U.S. Patent 5,771,279 to Cheston, III et al. in view of U.S. Patent 6,061,439 to Bleile et al.; claims 3-5 were rejected as being obvious over Cheston in of Bleile and further in view of U.S. Patent 6,243,373 to Turock; and claim 1 was rejected as being anticipated by U.S. Patent 5,539 to Wilkes. As set forth below, Applicants submit that claims 1-5 are not anticipated or obvious in view of the cited references.

A. Claims 1 and 2 are not obvious over Cheston in view of Bleile.

1. Cheston and Bleile fail to teach or suggest all of the elements of claim 1.

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim. See MPEP §2142. Applicants submit that the Office has not established a *prima facie* case of

obviousness with respect to claim 1 because not all of the elements of claim 1 are taught or suggested by Cheston and Bleile, taken alone or in combination. In particular, Applicants submit that Cheston and Bleile, taken along or in combination, fail to teach or suggest “providing telecommunications dialing features *for commercial classes of dedicated telephone service...*,” as recited in claim 1, among other things.

First, consider the Cheston reference. Although the Cheston reference discloses both commercial and residential customer premises equipment (“CPE”) in communication with an advanced intelligent network (“AIN”), nowhere does Cheston disclose that the AIN communicates with the commercial CPE via “commercial classes of dedicated telephone service,” as recited in claim 1. To the contrary, although the Cheston reference discloses some dedicated telephone communication channels (such as ISDN and T-1 lines) between components of the disclosed network, Applicants submit that the Cheston reference does not teach or even suggest a commercial class dedicated telephone communication channel for a terminating piece of CPE for providing enhanced dialing features.

The portions of the Cheston specification cited in the Office Action for the proposition that the Cheston reference teaches or suggests this feature, namely col. 2, lines 30-34 and lines 44-48, fails to provide the basis for teaching or suggesting the features of claim 1 described above. The text at col. 2, lines 30-34, merely states that similar to a business setting, residential CPE may be connected to a local area network (“LAN”) and that, therefore, both residential and business CPE have taken on the attributes of a network unto themselves. At col. 2, lines 44-48, the text of the Cheston reference merely discloses that some CPEs can control calling features internally. These portions of the Cheston specification, however, merely disclose that there may exist both residential and business CPEs and that some CPEs can control calling features

internally. Applicants submit, however, that the Cheston reference does not teach or suggest providing enhanced telecommunications dialing features *for commercial classes of dedicated telephone service*, as recited in the invention of claim 1.

The Bleile reference also fails to teach or suggest this feature of claim 1 (and, as a secondary reference, the Office does not rely on it as suggesting the feature).

Therefore, the combination of the Cheston and Bleile fails to teach or suggest, “providing enhanced telecommunications dialing features for commercial classes of dedicated telephone service,” as recited in claim 1.

2. The Office impermissibly relies on hindsight rationale in combining the Cheston and Bleile references.

Even if the combination Cheston and Bleile were to teach or suggest every element of claim 1, without a motivation or suggestion to combine the cited references, a rejection based on obviousness under § 103(a) is improper. *See* MPEP §2142. Possible sources for the motivation to combine references include: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. In order to safeguard against the use of hindsight based on Applicants’ disclosure, however, the Office must show a motivation to combine the cited references to support a determination of obviousness. In other words, the Office must present a convincing line of reasoning as to why a person of ordinary skill in the art, confronted with the same problem as the Applicants and without knowledge of the claimed invention, would pick and choose various elements from the cited references and combine them in such a way as to arrive at Applicants’ claimed invention.

In the obviousness rejection of claim 1, however, the Office Action is completely devoid of any possible sources that may give rise to the necessary motivation to make the alleged combination of the cited references so as to arrive at the invention of claim 1. It is unclear upon

what basis the Office relies to conclude that there was any motivation to combine the cited references to arrive at Applicants' invention. It is not apparent from the Office Action as to whether the Office relies on the nature of the problem to be solved, the teachings of the prior art or the knowledge of persons of ordinary skill in the art to conclude that there is proper motivation to make the alleged combination. The Office merely states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Bleile et al of providing dialing features from central office of the conventional PSTN services and applied into the commercial service of Cheston, III et al in order to broaden services to different network environment." No other reason was given by the Office in support of its conclusion that claim 1 was obvious.

In that connection, the Office gave no explanation as to the specific understanding or principle presumably within the grasp or knowledge of a person having ordinary skill in art that would motivate one without having specific knowledge of Appellant's invention to make the alleged combination. Therefore, one can reasonably infer that, absent such explanation, the Office selected the cited references with the assistance of hindsight. Resorting to the use of hindsight is not permissible to make out a case of obviousness when lacking a motivation to combine the cited references. Without the necessary motivation or suggestion to combine, the Office has failed to establish that claim 1 is obvious over the cited references.

Therefore, Applicants submit that claim 1 is not obvious over Cheston and Bleile. In addition, by virtue of their dependence upon claim 1, Applicants submit that claims 2-5 are also not obvious over the references cited in the Office Action.

B. Claim 1 is not Anticipated by Wilkes


A claim is anticipated only if each and every element as set forth in the claim is found,

either expressly or inherently, in the prior art reference. *See* MPEP § 2131. Applicants submit that Wilkes does not disclose, among other things, “providing *enhanced* telecommunications dialing features,” where the features are provided “at the central office,” as recited in claim 1. Rather, Wilkes merely discloses dialing an abbreviated extension to place a call to other stations within a group of telephone lines. *See* Wilkes, col. 1: 10-15 and col. 7: 34-49. Applicants submit that Wilkes does not disclose the provision of *enhanced* dialing features such as, for example, call tracing, call waiting, repeat calling, speed dialing and return calling. Therefore, Applicants submit that Wilkes does not anticipate claim 1.

CONCLUSION

Applicants respectfully request a Notice of Allowance for the pending claims in this application. If the Examiner is of the opinion that the instant application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned attorney of record at the telephone number listed below in order that the Examiner’s concerns may be expeditiously addressed.

Respectfully submitted,


Mark G. Knedeisen
Reg. No. 42,747

KIRKPATRICK & LOCKHART, LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222

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Fax (412) 355-6501